

REMARKS

By this Amendment, Applicant adds new claims 24-27. Claims 1-5, 7-11, 13-15, 17, 18, and 20-27 are pending.

In the last Office Action, the Examiner rejected claims 1-5, 7-11, 13-15, 17 and 18 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,663,105 ("*Sullivan*"); and rejected claims 20-23 under 35 U.S.C. § 103(a) based on *Sullivan* in view of U.S. Patent No. 5,740,549 ("*Reilly*").

CLAIMS 1-5, 7-11, 13-15, 17 AND 18

Applicant respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a) based on *Sullivan* because *prima facie* obviousness has not been established with respect to this claim.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143 (8th Ed. May 2004). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. *Id.* Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." *Id.*

Sullivan fails to teach or suggest at least "providing software instructions on each said webmaster server for collecting an e-mail address for said subscriber device and storing said e-mail address on said database by having an operator of said subscriber

device input said e-mail address and make a selection to opt-in for delivery of an ezine from a plurality of available ezines to said e-mail address; and providing software instructions on said ad server to facilitate delivery of said ezine to said subscriber device, wherein said ezine includes an ad,” as recited in claim 1.

Sullivan merely discloses distributing a validation code through e-mail to a user. *Sullivan*, 17:47-49. The e-mail can be sent to users who have opted-in to receive messages. *Id.*, 17:64-65. A user may enter the validation code at a store’s host web site 1440 to enjoy a prize. *Id.*, Fig. 14, 15:20-25. The prize may include allowing the user to choose a magazine article or story to read at the website and the user may then choose to subscribe to the magazine by selecting button 1904 at the website. *Id.*, 16:63-65, 17:18-22.

However, *Sullivan*’s disclosure is not the same as and does not suggest “providing software instructions on each said webmaster server for collecting an e-mail address for said subscriber device and storing said e-mail address on said database by having an operator of said subscriber device input said e-mail address and make a selection to opt-in for delivery of an ezine from a plurality of available ezines to said e-mail address; and providing software instructions on said ad server to facilitate delivery of said ezine to said subscriber device, wherein said ezine includes an ad,” as recited in claim 1. The Examiner has not provided any evidence demonstrating that the prior art teaches “having an operator of said subscriber device input said e-mail address and make a selection to opt-in for delivery of an ezine from a plurality of available ezines to said e-mail address” and “providing software instructions on said ad server to facilitate delivery of said ezine to said subscriber device, wherein said ezine includes an ad.”

Further, at page 3 of the Office Action (Item No. 5), the Examiner asserts that it would have been obvious to modify the disclosure of *Sullivan* such that the magazine is an ezine delivered to an email address because the invention operates online. The Examiner, however, has not provided any evidence within the prior art showing that one of ordinary skill in the art at the time of the invention would have been motivated to make such a modification. The Examiner only asserts that the modification would have been obvious because the invention operates online. This is impermissible because one cannot use Applicant's disclosure to provide the teaching or suggestion to make Applicant's invention. M.P.E.P. § 2143 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.") (citations omitted).

Accordingly, because a *prima facie* case of obviousness has not been established, the rejection of claim 1 should be withdrawn.

Further, the rejection of dependent claims 2-5 under 35 U.S.C. § 103(a) based on *Sullivan* should be withdrawn at least by virtue of their dependence upon allowable claim 1.

Although independent claims 1, 7, 13, and 17 have different scopes, the rejection of claims 7, 13, and 17 under 35 U.S.C. § 103(a) based on *Sullivan* should be withdrawn for reasons similar to the ones discussed above for claim 1. Also, the rejection of dependent claims 8-11, 14, 15, and 18 under 35 U.S.C. § 103(a) based on *Sullivan* should be withdrawn at least by virtue of their dependence upon allowable claims 7, 13, and 17.

CLAIMS 20-23

Applicant respectfully requests withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a) based on *Sullivan* in view of *Reilly*. *Reilly* merely discloses displaying news items and advertisements on a screen saver whenever a system detects a lack of user inputs for a specified length of time. *Reilly*, 11:43-48. The news items and advertisements are from a local database, which is updated according to a connection schedule. *Id.*, 8:19-31.

The Examiner admits at page 3 of the Office Action (Item Nos. 11 and 12) that neither *Sullivan* nor *Reilly* teaches “providing software instructions on each said webmaster server or ad server to allow subscribers to retrieve back issues with new ads,” as recited in claim 20. The Examiner, however, asserts that it would have been obvious to modify *Sullivan* with *Reilly* to do this because of the disclosure of *Sullivan* at column 13, lines 50-53 (cited by the Examiner on page 4 of the Office Action). This assertion is unsupported by evidence. Suggestions to modify a reference must be taught in the reference itself or in common knowledge available to one of ordinary skill in the art. M.P.E.P. § 2143. Column 13, lines 50-53 of *Sullivan* merely states “items or services for which there is an excess inventory or an ongoing promotional campaign may be awarded more e-points than other items or services.” That does not teach or suggest “providing software instructions on each said webmaster server or ad server to allow subscribers to retrieve back issues with new ads,” as recited in claim 20.

The Examiner also asserts that it would have been obvious to modify *Sullivan* to “[provide] software instructions on each said webmaster server or ad server to allow subscribers to retrieve back issues with new ads,” as recited in claim 20, because retrieval of back issues is a common source of revenue for magazines. To the extent

the Examiner is relying on common knowledge or well-known art to teach or suggest this, Applicant requests the Examiner provide Official Notice.

If the Examiner is relying on Official Notice, Applicant calls attention to the provisions of M.P.E.P. § 2144.03, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

Applicant submits that the features recited in claim 20 are not unquestionably well-known, and the Office Action does not demonstrate to the contrary. Simply stating that features of a system and method were common knowledge does not establish that such subject matter is in fact unquestionably well-known. As M.P.E.P. § 2144.03 makes clear, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted).

Accordingly, for the above reasons, a *prima facie* case of obviousness has not been established for claim 20, and the rejection of claim 20 should be withdrawn.

The rejection of claims 21-23 under 35 U.S.C. § 103(a) based on *Sullivan* in view of *Reilly* should be withdrawn for reasons similar to the ones discussed above for claim 20.

NEW CLAIMS 24-27

Applicant has added new claims 24-27, to claim additional aspects consistent with features of the invention. No new matter has been added.

Claims 24-27 are allowable at least by virtue of their dependence upon allowable independent claims 1, 7, 13, and 17, respectively, in addition to the patentable subject matter recited therein.

CONCLUSION

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

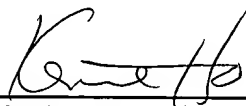
Applicant notes that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicant declines to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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